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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,291	07/13/2001	Yoichiro Sako	7246/63014	1447
7590	02/15/2005		EXAMINER	
Jay H Maioli Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036			PERUNGAVOOR, VENKATANARAY	
		ART UNIT	PAPER NUMBER	
		2132		

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/889,291	SAKO ET AL.
	Examiner	Art Unit
	Venkatanarayanan Perungavoor	2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 July 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-84 is/are pending in the application.
 4a) Of the above claim(s) 29-84 is/are withdrawn from consideration.
 5) Claim(s) 25 and 26 is/are allowed.
 6) Claim(s) 1-24,27 and 28 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 13 July 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

1. The inventions are distinct, each from other because:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1-28, drawn to a data-recording medium in which data is recorded by dividing a recording area into at least first and second recording areas, classified in class 386, subclass 45.
- II. Claims 30, 36-39, drawn to a data recording apparatus for recording data in a recording medium having a disk dimension, classified in class 386, subclass 124.
- III. Claims 40, drawn to a data reproducing apparatus for reproducing data from a discoid recording medium having a disk dimension, classified in class 386, subclass 82.
- IV. Claims 41-52, drawn to a discoid recording medium, classified in class 386, subclass 106.
- V. Claims 53-63, drawn to a discoid-recording-medium reproducing Apparatus, classified in class 386, subclass 105.
- VI. Claims 64-80, drawn to a discoid recording medium, classified in class 386, subclass 125.
- VII. Claims 81-84, drawn to a recording medium copy control method, classified in class 386, subclass 94.

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2. Inventions stated in Groups I- VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention relating to each of the methods for providing an data recording apparatus where each of the subcombination can be used separately for each other without loss of utility. See MPEP j 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Groups I is not required for Group 11, 111, IV, V, VI, VII, restriction for examination purposes as indicated is proper.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in

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the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. During a telephone conversation with Mr. Jay Maioli on 1/18/05 a provisional election was made on Claim 1-28 with the right to traverse to prosecute the invention of Recording medium, data recording method and apparatus, data reproducing method and apparatus, and copying control method, claim 1-28. Affirmation of this election must be made by applicant in replying to this Office action. Claim 29-84 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specifications

8. On Page 49, Line 9, The Applicant mentions "step 25" but "step 25" is not disclosed in the Figure 15. The Examiner believes the Applicant meant "S25". Appropriate correction required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1, 2, 4,13, 27, 28 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5915017 to Sung et al.

11. Regarding Claim 1 are met by Sung et al.,

The "first data to be recorded in said first recording area are unencrypted data and at least a part of second data to be recorded in said second recording area are encrypted data; and compression rates of said first data and said second data are different" **see Column 3 Line 33-60.**

12. Regarding Claim 2, The "first data and said second data have different contents" **see Column 3 Line 33-60.**

13. Regarding Claim 4, The "first data are uncompressed data and said second data are compressed data" **see Column 3 Line 33-60.**

14. Regarding Claim 13, Claim 27 and Claim 28 is rejected under the rationale as Claim 1 above.

Claim Rejections – 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 12 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 5915017 to Sung et al. in view of U.S. Patent 5802174 to Sako et al.

17. Sung et al. does not disclose second data recorded in said second recording area are data to be charged when reproduced and data for charging are recorded in a data management area. However, Sako et al. discloses second data recorded in said second recording area are data to be charged when reproduced and data for charging are recorded in a data management area **see Column 3 Line 13-40**. It would be obvious to one having ordinary skill in the art at the time of the invention to include second data recorded in said second recording area are data to be charged when reproduced and data for charging are recorded in a data management area in order to have light-pickup devices read data **see Column 3 Line 13-20**.

18. Claim 3, 5, 6, 7, 8-11,13, 22-24 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5915017 to Sung et al. in view of Reissued Patent RE37327E to Yonemitsu et al..

19. Regarding Claim 3, 5, 6, 7, Sung et al. does not disclose having first data and second data being identical and also does not disclose having data management information. However, Yonemitsu et al. discloses, The "first data and said second data

have identical contents" [see **Column 3 Line 10-13**]; The "data management area in which management information showing whether said second data are recorded is formed on said recording medium"[see **Column 3 Line 13-21 & Column 3 Line 25-32**]; The "data management area in which management information showing whether said first data and second data are identical is recorded is formed on said recording medium"[see **Column 3 Line 13-21 & Column 3 Line 25-32**]; The "data management information showing positions of said first data and said second data is recorded in said recording medium"[see **Column 3 Line 13-21 & Column 3 Line 25-32**]. It would be obvious to one having ordinary skill in the art at the time of the invention to include data management area in order to have information about the contents stored[see **Column 3 Line 25-32**].

20. Regarding Claim 8, 9,10,11,13, 22, 23, 24 Sung et al. does not disclose having data recorded on a disk. However, Yonemistu et al. discloses, The "first data and said second data have different data formats"[see **Figure 8 & Figure 10A**]; The "recording medium is a discoid recording medium"[see **Figure 1 item 100**]; The "first recording area is formed at an inner-track side and said second recording area is formed at an outer-track side" [see **Figure 4A**]; The "data recorded in said first recording area and said data recorded in said second recording area have different compression rates based on a track pitch, a linear velocity, and a data format"[see **Column 6 Line 50-63**]; The "first recording area allowing data for a specified maximum regeneration time to be recorded by recording first data in accordance with a lower limit of an allowable

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width said track pitch and a lower limit of an allowable width of said minimum pit length; and second recording area allowing second data for said maximum regeneration time to be recorded, wherein said first data and said second data are discontinuously recorded" [see Abstract¹ & Column 6 Line 29-49]; The "second data are encrypted data" [see Column 3 Line 10-13]; The "first recording area is formed at an inner-track side and said second recording area is formed at an outer-track side" [see Figure 4A]; The "first lead-in area formed at said inner-track side of said first recording area and a first lead-out area formed at said outer-track side of said first recording area are included; and a second lead-in area formed at said inner-track side of said second recording area and a second lead-out area formed at said outer-track side of said second recording area are included" [see Figure 5]. It would be obvious to one having ordinary skill in the art at the time of the invention to include having data recorded on a disk because of its conventional availability see Column 1 Line 52-66.

21. Claim 14 is rejected under the same rationale as Claim 2 above.
22. Claim 15 is rejected under the same rationale as Claim 3 above.
23. Claim 16 is rejected under the same rationale as Claim 4 above.
24. Claim 17 is rejected under the same rationale as Claim 5 above.
25. Claim 18 is rejected under the same rationale as Claim 6 above.
26. Claim 19 is rejected under the same rationale as Claim 7 above.

¹ The maximum regeneration time defined in Specification page 18 Line 11-13. Maximum regeneration time defined as a function of track pitch and linear velocity. And in the instant case, the Applicant says

27. Claim 20 is rejected under the same rationale as Claim 8 above.

Allowable Subject Matter

28. Claim 25 and Claim 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

29. The following patents are cited to further show the state of art in general:

U.S. Patent No. 6167136 to Chou

U.S. Patent No. 5901127 to Kanashima et al.

U.S. Patent No. 5563714 to Inoue et al.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Venkatanarayanan Perungavoor whose telephone number is 571-272-7213. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Venkatanarayanan Perungavoor
Examiner
Art Unit 2132

VP
2/1/05

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